

Serial No. **10/029,279**

Docket No. **P-0280**

Amendment dated June 15, 2006

Reply to Office Action of April 3, 2006

REMARKS

Entry of the amended claims is proper under 37 C.F.R. §1.116 since the amendments: (1) place the application in condition for allowance (for the reasons discussed herein); (2) do not raise any new issues requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution without incorporating additional subject matter); (3) satisfy a requirement of form asserted in the previous Office Action; and/or (4) place the application in better form for appeal (if necessary). Entry is thus requested.

By the present response, Applicant has amended claims 1, 7, 10, 14, 17 and 21 to further clarify the invention. Claims 1-23 remain pending in this application. Reconsideration and withdrawal of the outstanding rejections and allowance of the present application are respectfully requested in view of the above amendments and the following remarks.

In the Office Action, claims 1, 2, 4-11, 13-15 and 21-23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,832,384 (Balachandran) in view of U.S. Patent No. 6,212,388 B1 (Seo). Claims 3, 12 and 16-20 have been rejected under 35 U.S. C. § 103(a) as being unpatentable over Balachandran in view of Seo, and further in view of admitted standards IS-95, IS-95A, IS-95B and IS-2000 (Standards).

Response to Arguments

The Examiner states that Applicant's arguments filed on January 17, 2006 are not persuasive. The Examiner bases most of his support for his assertions by removing and ignoring

limitations in the claims of the present application in an attempt to broaden the interpretation of the limitation such that it reads on the asserted prior art. For example, the Examiner chooses to ignore the terms “CDMA” and “extended CDMA” in an attempt to broaden the scope of Applicant’s claimed “CDMA channel list” and “Extended CDMA channel list” to merely relate to any type or kind of “channel list”. Although, the Examiner is allowed to give the terms and limitations in the claims of the present application their broadest interpretation, the Examiner has gone far beyond this. The Examiner has instead broadened the limitations in the claims of the present application by completely ignoring certain terms and phrases in the limitations of the claims. Justification for an Examiner ignoring and disregarding terms in the limitations of the claims of an application is not supported by any U.S. patent laws, case law, or the rules and regulations of the PTO including the MPEP.

MPEP § 2111, in citing various supporting case law, states that during patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. Further, the broadest reasonable meaning of the words in the claims must be consistent with their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in Applicant's specification. The Examiner has failed to follow existing law and rules by ignoring terms in Applicant’s claims. It is clear from the Applicant’s disclosure, as read and as understood by one of ordinary

skill in the art, that embodiments of the present invention relate specifically to a CDMA channel list and an Extended CDMA channel list, as recited in the claims.

In maintaining that Balachandran et al. discloses determining whether a frequency exists on each of a CDMA channel list and an extended CDMA channel list when a service frequency of a base station of a frequency is changed, the Examiner makes incorrect assertions. For example, on page 21 of the Office Action, the Examiner states that “the fact that the claim channel list are called CDMA channel list ...is not given weight by the Examiner because the claimed inventive steps are not the CDMA channel lists themselves but how the context of the lists are copied from one list to the other”. The Examiner is not allowed to remove terms and phrases from the limitations in the claims merely because they are not disclosed in the cited reference in an attempt to read the claims on the reference. The Examiner is required to take each limitation in combination as it relates to any asserted reference. Here, the Examiner erroneously asserts that any channel list is the same, which is incorrect. For clarification, Applicant has amended the claims to provide further details regarding the CDMA channel list and the extended CDMA channel list.

Moreover, the Examiner now asserts that Balachandran et al. at col. 3, lines 6-12 discloses Applicant’s claimed determining whether a frequency exists on the channel list. However, these portions merely disclose determining which channel, from among a plurality of shared channels assignable to a first communications network and second communications network, will be used

next for communicating information by the second network. A number of flags and indicators are used to determine which channel will be used next. In contrast, the limitations in the claims of the present application relate to determining whether a frequency exists, thus implying a comparison of a particular frequency with frequencies on the list. Balachandran et al. merely discloses selection of a channel by utilizing a number of flags and indicators. These are two completely different concepts.

The Examiner states that “in the process of creating an idle _channel list, the process must first determine whether a channel (frequency) is being used by either of the communications network (i.e., exists on the channel list)”. The Examiner thus states that Balachandran et al. discloses three channels that discloses the channels in the claims of the present application, specifically, the channel list for the first communications network, the channel list for the second communications network, and the idle_channel list. This is not determining whether a frequency exists on a CDMA channel list and an extended CDMA channel list, and subsequently, copying a frequency allocated from one list to the other list if it is determined not to exist on the initial channel list. The limitations in the claims of the present application relate only to two CDMA channel lists.

The Examiner further states that Balachandran discloses a portion of a limitation “when a service frequency of a base station is changed”, at col. 3, lines 33-50 with the disclosure of the backup zone where channels used by the second communication system are released. However,

an end system and a base station coordinating to establish a channel change of channels from the second communication network to the backup zone for use by the first communications system, has nothing to do with a base station changing a service frequency, and in response determining whether a frequency exists on a CDMA channel list and an extended CDMA channel list. These portions merely relate to the fact that the first communication channel in Balachandran et al. must have available channels and if the backup zone of available channels falls below a particular level, channels are taken from the second communications network.

Further, the Examiner now asserts that Seo discloses copying a frequency allocated to the extended CDMA channel list to the CDMA channel list if the frequency is determined not to exist on the CDMA channel list, and copying a frequency allocated to the CDMA channel list to the extended CDMA channel list if the frequency is determined not to exist on the extended CDMA channel list, at col. 5, lines 2-9 by Seo disclosure of generating a first channel list and a second channel list each including a newly added FA and one including all FAs. Applicant fails to understand the Examiner's logic in first asserting that Seo discloses a first channel list having a newly added FA and a second list including the newly added FA, but the newly added FA was copied from one list to another. Seo discloses each list being originally generated and including the newly added FA. Seo does not disclose or suggest any copying of the newly added FA from one list to another list that did not have a newly added FA since both lists were originally generated with the newly added FA. Further, the limitations in the claims of the present

application include two separate and distinct limitations of (1) copying a frequency allocated from an extended CDMA channel list and (2) copying a frequency allocated to the CDMA channel list to the extended CDMA channel list. A reference disclosing the simple copying of a frequency from one list to the other does not satisfy both limitations in the claims of the present application.

Since the majority of the Examiner's support for his assertions is based on unjustifiable ignoring of limitations in the claims of Applicant's application, Applicant need not address the remaining remarks in the "Response to Arguments" section the Office Action.

35 U.S.C. §103 Rejections

Claims 1, 2, 4-11, 13-15 and 21-23 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Balachandran in view of Seo. Applicant has discussed the deficiencies of each of these references in Applicant's previously filed response and reasserts all arguments submitted in that response. Applicant respectfully traverses these rejections and provides the following additional remarks.

Regarding claims 1, 7, 10, 14 and 21, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of each of these claims of, *inter alia*, determining whether a frequency exists on each of a CDMA channel list and an extended CDMA channel list when a service frequency of a base station is changed, copying a frequency allocated to the extended CDMA channel list to

the CDMA channel list if the frequency is determined not to exist on the CDMA channel list, copying a frequency allocated to the CDMA channel list to the extended CDMA channel list if the frequency is determined not to exist on the extended CDMA channel list, where the CDMA channel list comprises a bundle of frequency allocations usable for second generation (2G) mobile station service and the extended CDMA channel list comprises a bundle of frequency allocations usable for third generation (3G) mobile station service.

None of the cited references disclose or suggest anything related to a CDMA channel list or an extended CDMA channel list where the CDMA channel list comprises a bundle of frequency allocations usable for 2G mobile station service and the extended CDMA channel list comprises a bundle of frequency allocations usable for 3G mobile station service.

Regarding claims 2, 4-6, 8, 9, 11, 13, 15, 22 and 23, Applicant submits that these claims are dependent on one of independent claims 1, 7, 10, 14 and 21 and, therefore, are patentable at least for the same reasons noted previously regarding these independent claims.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of each of claims 1, 2, 4-11, 13-15 and 21-23 of the present application. Applicant respectfully requests that these rejections be withdrawn and that these claims be allowed.

Claims 3, 12 and 16-20 have been rejected under 35 U.S.C §103(a) as being unpatentable over Balachandran et al. in view of Seo and Standards. Applicant has discussed the deficiencies

of each of these references in Applicant's previously filed response and reasserts all arguments submitted in that response. Applicant respectfully traverses these rejections and provides the following additional remarks.

Regarding claim 17, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose suggest or render obvious the limitations in the combination of this claim of, *inter alia*, a base station configured to copy frequencies allocated on a CDMA channel list to the extended CDMA channel list and to copy frequencies allocated on the extended CDMA channel list to the CDMA channel list where the CDMA channel list comprises a bundle of frequencies allocations usable for 2G mobile station service and the extended CDMA channel list comprises a bundle of frequency allocations usable for 3G mobile station service. The Examiner asserts Balachandran et al. and Seo and admits that these references do not disclose or suggest anything related to a CDMA channel list and an extended CDMA channel list. The Examiner brings in the known standards to support the second generation and third generation terminal limitations. Applicant respectfully submits that the Examiner is required to identify each and every limitation, taken in combination with each other, in the assertion of the prior art. The Examiner is not allowed to pick and choose limitations randomly from various references in an attempt to put together the limitations in the claims of the present application. Although 2G terminals, 3G terminals, and channel lists in general may

Amendment dated June 15, 2006Reply to Office Action of April 3, 2006

be known, none of the cited references disclose or suggest the limitations in combination, as recited in the claims of the present application.

Moreover, the Examiner has failed to provide adequate motivation suggesting that one of ordinary skill in the art would combine these various references in an attempt to achieve the limitations in the claims of the present application. In this regard, the Examiner appears to use impermissible hindsight in reading the limitations in the claims of the present application back into the cited references. The Federal Circuit has forbidden the use of hindsight in the selection of references that comprise the case of obviousness. See, In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). Moreover, as the Federal Circuit has stated in In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998) at pages 1457 and 1458:

As this court has stated, "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." Sensonic, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

Applicant respectfully submits that the Office Action relies on impermissible hindsight as there is no suggestion in the prior art for the features and/or combinations. That is, it is well-founded that when a rejection depends on a combination of prior art references, there must be some teachings, suggestion, or motivation to combine the references. See ACH Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) and In re Geiger, 815 F.2d, 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). Applicant believes that there is no teaching, suggestion, or motivation to combine the references and the rejection of all the claims should be withdrawn at least for this reason. Applicant further believes that the Office Action relies on impermissible hindsight to combine the features of the applied references (as well as the “non-applied references”). That is, there is no suggestion in the references to make the combination. Rather, the only motivation is provided in applicants’ own specification. The Office Action can not use Applicant’s own specification as a “road map” to find the claimed features. As stated in In re Gorman, the references themselves must provide some teaching whereby the Applicant’s combination would have been obvious. The Office Action therefore relies on impermissible hindsight. The applied references do not contain any teaching whereby the claimed features would have been obvious. Additionally, the Office Action clearly relies on a piecemeal reconstruction of the prior art in order to find claimed features. In view of this, the combination and rejections are improper and should be withdrawn.

Serial No. **10/029,279**

Docket No. **P-0280**

Amendment dated June 15, 2006

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Regarding claims 3, 12, 16 and 18-20, Applicant submits that these claims are dependent on one of independent claims 1, 10, 14 and 17 and, therefore, are patentable at least for the same reasons noted previously regarding these independent claims.

Accordingly, Applicant submits that none of the cited references, taken alone or in any proper combination, disclose, suggest or render obvious the limitations in the combination of each of claims 3, 12, and 16-20 of the present application. Applicant respectfully requests that these rejections be withdrawn and that these claims be allowed.

Serial No. **10/029,279**

Docket No. **P-0280**

Amendment dated June 15, 2006

Reply to Office Action of April 3, 2006

CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that claims 1-23 are now in condition for allowance. Accordingly, early allowance of such claims is respectfully requested. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, Frederick D. Bailey, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

Respectfully submitted,
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